

**REMARKS**

**I. Introduction**

Claims 8 to 16 are currently pending in this application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note that the Office Action Summary indicates that a copy of a certified copy of the priority document has not been received from the International Bureau. Applicants will submit a certified copy of the priority document under separate cover.

**II. Rejection of Claims 8 to 14 and 16 Under 35 U.S.C. § 103 (a)**

Claims 8 to 14 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,949,492 ("Mankovitz"). Applicants respectfully submit that Mankovitz does not render obvious the present claims for the following reasons.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Applicants submit that the interpretation that the Examiner has taken of the claim terms, as expressed in the Response to Arguments section of the Final Office Action, completely reads limitations out of the claims. While the Examiner cursorily acknowledges that "claims are viewed in light of the specification," this basic tenet of claim construction is not given any effect and therefore that claims have not been given their broadest reasonable interpretation.

Independent claim 8 recites a method for transmitting information between an infrastructure and data users in which the infrastructure includes a service provider and the data users include terminal devices in a motor vehicle and

have specific data processing capabilities. As recited, the data service is made available in a standardized format using the infrastructure and the data in the standardized format is adapted to the data processing capabilities of the data users via the interfaces situated in the infrastructure.

It is not understood how the transmission apparatus of Mankovitz in any way discloses or suggests the features of claim 8. Mankovitz describes a system whereby a receiver of a broadcast can request auxiliary information regarding a particular broadcast program by recording the station, date and time (SDT) information of the broadcast and then transmitting this information to a central station that servers as a "remote program information retrieval system". Col. 8, lines 25 to 55. At the central station, the auxiliary information is retrieved based on the (SDT) information and then delivered physically or transmitted by modem to the requester. Col. 9, lines 20 to 35. Significantly, there is no disclosure or suggestion that the central station includes one or more interfaces for adapting the auxiliary data from a standardized format according to the data processing capabilities of the requesters, and thus it is not understood how the system of Mankovitz renders obvious the subject matter of claim 8.

Additionally, in the Response to Arguments section of the Final Office Action, the Final Office Action equates the broadcast transmitter of Mankovitz with the interfaces recited in claim 8. This position is not correct at least because the recited interfaces, unlike the broadcast transmitter of Mankovitz, adapt data from a standardized format to a data processing capability of a data user. The Final Office Action appears to be ignoring the adaptation function of the interfaces because it is clear that Mankovitz does not concern modifying auxiliary data according to the data processing capabilities of the requesting users.

Moreover, the notion that "interfaces" can be construed broadly enough to encompass an FM broadcast transmitter is precluded by the clear guidance of the Specification which provides the following:

It is the task of these interfaces 6, 7 to adapt the data provided by data service 4 to the capabilities of terminal devices 1, 2 and, correspondingly, to adapt to data service 4 the information sent by terminal devices 1, 2 to data provider 3. **Interfaces are understood here to mean interface converters which are, for example, configured in the form of software and adapt the data from the terminal device to the data service or in reverse direction.** For example, terminal device 1 can have a voice input. This voice data is then transmitted to interface 6

and processed there into appropriate information for data service 4.

Specification, page 4, line 27 to page 5, line 5 (emphasis added). Thus, since an FM broadcaster in general, and the FM broadcaster according to Mankovitz in particular, do not perform such data conversion, it is submitted that the interpretation that the Final Office Action has drawn is not accurate. Applicants also direct the attention of the Examiner, in this regard, to the discussion on page 5 of the Specification which discusses how the various interfaces (6, 7) adapt the standardized data to the different hardware of the various terminal devices (i.e., different screen sizes) which are associated with different capabilities with respect to the processing and display of data. Thus, in the example illustrated each interface at the infrastructure would be assigned the task of fitting the standard data to best accommodate the respective capabilities of the different terminal devices.

Notwithstanding the foregoing, the Examiner will note that claim 8 has been amended herein without prejudice to recite that the data users have different specific data processing capabilities and that the method includes, via interfaces situated in the infrastructure, adapting data in the standardized format to the different data processing capabilities of the data users. Support for the foregoing amendments may be found, for example, on page 1, lines 23 to 25 and page 4, lines 16 to 19 of the Specification. Mankovitz does not disclose, or even suggest, that receivers 16a, 16b, 16c -- or any other elements -- have different specific data processing capabilities or that data is adapted in a standardized format to different data processing capabilities of data users.

As the subject matter set forth in claim 8 is clearly not disclosed or suggested by Mankovitz, it is respectfully submitted that Mankovitz does not render unpatentable claim 8. As claims 9 and 10 depend from claim 8 and therefore include all of the limitations of claim 8, it is respectfully submitted that Mankovitz does not render unpatentable claim 8. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

As independent claim 11, as amended herein without prejudice, recites a terminal device for a reception of data from an infrastructure that has specific different data processing capabilities for processing the data which the infrastructure makes available, the infrastructure providing the data via interfaces that adapt the

standard format data to the different data processing capabilities of the terminal device and means for transmitting a request signal to the infrastructure via which data is requested from the infrastructure and with which information concerning the different data processing capabilities is transmitted via the terminal device to the infrastructure, it is respectfully submitted that Mankovitz does not render unpatentable claim 11 for essentially the same reasons given above with respect to the patentability of claim 8.

Since claims 12 to 14 depend from claim 11 and therefore include all of the limitations of claim 11, it is respectfully submitted that Mankovitz does not render unpatentable these dependent claims for at least the reasons given above in support of the patentability of claim 11. *Id.*

As independent claim 16, as amended herein without prejudice, recites features analogous to those of claim 11, it is respectfully submitted that Mankovitz does not render unpatentable claim 16 for at least the same reasons given above in support of the patentability of claim 11.

### **III. Rejection of Claim 15 Under 35 U.S.C. § 103 (a)**

Claim 15 was been rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Mankovitz and U.S. Published Patent Application No. 2003/0069029 ("Dowling et al."). Applicants respectfully submit that the combination of Mankovitz and Dowling et al. does not render unpatentable claim 15 for the following reasons.

The present application is a national stage application based on PCT International Application No. PCT/DE98/02407, filed on August 19, 1998. Accordingly, the present application has an effective U.S. filing date of August 19, 1998, which is earlier than the April 10, 2003 publication date of Dowling et al. and earlier than the earliest U.S. filing date of Dowling et al., namely, November 17, 1998. Furthermore, the present application claims priority to Application No. 197 50 361.6, filed in the Federal Republic of Germany on November 14, 1997. A claim for priority to German Application No. 197 50 361.6 was made, inter alia, in the "Combined Declaration and Power of Attorney for Patent Application," filed on May 15, 2000, and, as indicated above, a certified copy of Germany Application No. 197 50 361.6 is being filed under separate cover. A certified translation of Germany Application No. 197 50 361.6 is submitted herewith.

In view of the foregoing, it is respectfully submitted that Dowling et al. do not constitute prior art against the present application. Withdrawal of this rejection is therefore respectfully requested.

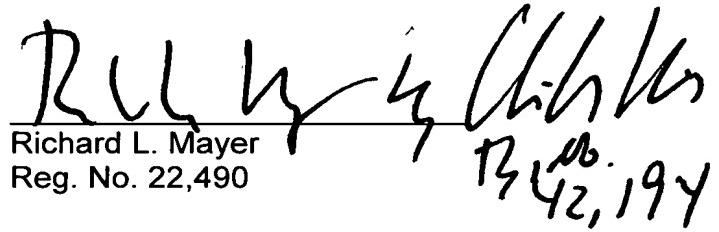
**IV. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: November 26, 2003 By:

  
Richard L. Mayer  
Reg. No. 22,490

One Broadway  
New York, New York 10004  
(212) 425-7200  
**CUSTOMER NO. 26646**